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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,010	04/03/2004	Gordon Walker Nugent		1590

7590
Gordon W. Nugent
160 Rivergate Drive
Wilton, CT 06897-3611

05/02/2006

EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,010

Applicant(s)

NUGENT, GORDON WALKER

Examiner

Frank Vanaman

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3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2006 has been entered.

Status of Application

2. Claims 46-55 are pending, claims 1-45 being canceled.

Claim Rejections - 35 USC § 112

3. Claims 46-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 46, lines 4-7 and claim 51, lines 4-7, the recitations of avoiding intrusion into an interior space and avoiding interference with access are confusing in that it is not clear what particular structural attribute (or lacking thereof) is specifically being set forth, further, with respect to claim 46, it is not entirely clear whether or not the container is considered to be part of the invention, or whether particular (un-recited) structural attributes associated with the container are required for a complete recitation; further the nature of the 'access' required to meet the claim limitations is not clearly set forth. As regards claim 51, it appears from a reading of line 8 that the burden is deemed to be included in combination with the cart, however, the particular structural attributes of the burden required to meet the claim recitation are not set forth in a clear and unambiguous manner. As further regards claims 50 and 55, it is not entirely clear if all of the containers/burdens specifically include structural characteristics which allow compliance with the conditions set forth in claims 46 and 51.

4. As regards claims currently rejected under 35 USC §112, second paragraph, please note that rejections under 35 USC §102 and 103 should not be based upon considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims when the claims are not definite. See *In re Steele* 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can

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be ascribed to certain terms in a claim, the subject matter does not become anticipated or obvious, but rather the claim becomes indefinite. See *In re Wilson* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As such the currently pending claims may be subject to prior art rejections not set forth herein upon the clarification of the claim language.

Claim Rejections 35 USC §103

5. The portions of 35 USC relied upon herein may be found cited in a previous office action.

6. Claims 46-55 are rejected as being unpatentable over Raichlen (US 6,540,242) in view of Watson (US 6,394,471, cited previously) Raichlen teaches a metallic-tube hand truck cart (10) which may be used with loads ("A"- note from the discussion of Prior Art in Raichlen that the accommodation of containers is deemed to be a very common use), including a quick attach/detach lock (16, 17, 18, 19, 20) based on a sliding/pivot mechanism (see figure 6), the lock being of a size to avoid 'substantial intrusion' into the space above a container (by dint of its comparatively small width, see figure 1, and which is illustrated as not extending inwardly of a container), which co-acts with a ledge (13) of smaller width than a load (e.g., "A"), which can be used to move merchandise from a shopping establishment to a vehicle and throughout a user's residence. The reference to Raichlen fails to explicitly teach the metallic tubing to be a "light alloy", to the breadth such is actually recited in the claims, however the examiner notes that nearly every metallic structural element is an alloy to the breadth claimed, and inasmuch as aluminum, for example, is notoriously old and well known for the construction of carts, and a comparatively light material, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an aluminum alloy for the purpose of constructing a lightweight yet strong cart.

The reference to Raichlen fails to teach (a) the provision of plural ledges and lock elements and (b) the use of a particular container structure. Watson teaches a carrier which can accommodate a plurality of baskets (31, 32, 33) having hinged ends, each separately supported on a load support (18, 20, 22). It would have been obvious to one of ordinary skill in the art at the time of the invention to duplicate the ledge and lock

structure taught by Raichlen, as suggested by the plural load accommodation taught by Watson, for the purpose of allowing a user to move more than a single load at one time.

In general, the examiner notes (as mentioned previously) that the duplication of parts already taught by the prior art, for the purpose of amplifying or enhancing the function that the taught parts perform, is not beyond the skill of the ordinary practitioner.

Response to Comments

7. Applicant's comments have been carefully considered. In response to applicant's argument that the references must explicitly provide a suggestion for combining, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

As regards the references teaching against one another, the examiner does not agree, in that the duplication of parts already taught in the prior art (e.g., to provide a plurality of ledges; a plurality of locks) is not beyond the skill of the ordinary practitioner, and *Watson* is relied upon primarily to teach that it is well known to provide a plurality of supports for a plurality of containers, rather than a specific structure. Applicant should note further that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant's comments, speculating on the results of the

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provision of a plurality of ledges and locks as taught by Raichlen are noted, but do not appear to be accompanied by any evidence that such results would inherently be derived from the combination.

Applicant's comments concerning the unexpected benefits of the inventive cart are noted, however there is no showing of evidence that the results are indeed unexpected. Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof. Applicant stresses that the presentation of two rather than one basket has invited a different behavior, however there is no evidence that presenting a pair of baskets in association with another prior art device would not invite the same reactive behavior.

Applicant's comments directed to the examiner's having 'reached beyond' the filed of a shopping cart are not at all persuasive, inasmuch as the reference to a shopping cart is entirely functional and fails to provide a structural distinction of any type.

Conclusion

8. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

F. VANAMAN
Primary Examiner
Art Unit 3618

Handwritten signature of F. Vanaman, dated 5/1/06.